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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
NG(MS)7192

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On 7 June 2006

Signature Lisa L. Pringle

Typed or printed Name Lisa L. Pringle

Application Number	Filed
10/027,944	19 December 2001
First Named Inventor	
Kenneth W. Aull	
Art Unit	**Examiner**
2132	V. Perungavoor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration No. 43,660

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 ____

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6-7-06
Date

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

PATENT

I HEREBY CERTIFY THAT ON THE DATE SHOWN BELOW, THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, AS "EXPRESS MAIL POST OFFICE TO ADDRESSEE" MAILING LABEL NO. EV852552010US

ON 7 JUNE 2006

SIGNATURE LISA L. PRINGLE

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Kenneth Aull et. al.
Serial No.	:	10/027,944
Filing Date	:	December 19, 2001
For	:	REVOCATION AND UPDATING OF TOKENS IN A PUBLIC KEY INFRASTRUCTURE
Group Art Unit	:	2132
Examiner	:	Venkatanaray Perungavoor
Attorney Docket No.	:	NG(MS)7192

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action filed in this case on May 16, 2006, please enter and consider the following remarks

Remarks/Arguments begin on page 2 of this paper.

REMARKS

Claims 9-13 and 18-28 are currently pending in the subject application, and are presently under consideration. Claims 9-13 and 18-28 are rejected. Favorable reconsideration of the application is requested in view of the comments herein.

I. Rejection of Claims 9-13 and 18-28 Under 35 U.S.C. §102(b)

Claims 9-13 and 18-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,757,920 to Misra, et al. ("Misra"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

It is respectfully submitted that the rejection of claims 13, 25 and 27 as being anticipated by Misra was made in error. It appears that claims 13, 25 and 27 were mistakenly rejected under an anticipation rejection (See Page 2, Paragraph 4 of the Final Rejection) and an obviousness rejection (See Page 4, Paragraphs 12-14 of the Final Rejection), wherein there are specific arguments set forth only for the obviousness rejection of claims 13, 25 and 27. Accordingly, only the obviousness rejection will be addressed in the present pre-appeal brief summary.

Misra does not anticipate claim 9. In response to the Final Office Action of March 8, 2006, ("Final Response"), on pages 2-4, Applicant clearly sets forth as to why Misra fails to disclose the elements of claim 9. Specifically, Misra does not disclose encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with a token identification in a database to form a download packet, as recited in claim 9. Misra discloses that a digitally signed and sealed certificate is created by initially generating a hash (using a one way hash function) of the contents within the signed and sealed certificate (See Misra, Col. 5, Line 65-Col. 6, Line 3 and Col. 6, Lines 3-5). A hash function is an algorithm that turns messages or text into a fixed string of digits, usually for security or data management purposes. A one way hash function means that there is generally no known method for deriving the original text from the string. A one-way hash function can be used to create digital signatures, which in turn identify and authenticate the sender and message of a digitally distributed message. In contrast, claim 9 recites encrypting all

certificates/private keys using a public key associated with a token identification in a database. The certificates/private keys encrypted with the public key recited in claim 9 can be decrypted with the public key's associated private key (the private key in the token). Thus, the hash function disclosed in Misra is a completely different type of encryption from the encrypting recited in claim 9. Therefore, the hash of the contents within the signed and sealed certificate does not correspond to the download packet recited in claim 9. Accordingly, the section of Misra cited in the Final Rejection does not disclose encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with a token identification in a database to form a download packet, as recited in claim 9. In the Advisory Action issued on May 16, 2006, ("Advisory Action") in response to the above arguments, the Examiner contends that Misra discloses the use of public/private key pairs for encryption and decryption. In as much as this is true, Misra still does not disclose implementing public/private key encryption and decryption in the manner claimed by the method of claim 9. Thus, it appears that the Examiner is attempting to impermissibly broaden the scope of Misra.

Additionally, Misra does not disclose encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with a token identification in a database to form a download packet, as recited in claim 9. Misra discloses that a user may request to download a logon certificate to a removable storage media, such as a floppy diskette, and when the user requests to download the logon certificate, the user is prompted to supply a password (See Misra, Col. 6, Lines 63-67). Misra also discloses that a one way hash function is used to hash the password, which is used to generate an encryption key, which is used to encrypt the logon certificate (See Misra, Col. 6, Line 67-Col 7, Line 3). Further still, Misra discloses that the password can be later used to generate an encryption key, which can be used to decrypt the logon certificate so that it can be retrieved from the remove storage media (See Misra, Col. 8, Lines 27-31). Thus, the password disclosed in Misra can act as a symmetric key, that is, a key can encrypt and decrypt the same data. Conversely, in the public and private key pairs recited in claim 9, when a data has been

encrypted with the public key, that data can only be decrypted by a corresponding private key, and not the public key. Thus, the encrypted certificate on the removable storage media disclosed in Misra is not encrypted using public/private key encryption, but rather symmetric encryption. Therefore, the encrypted certificate disclosed in Misra does not correspond to the download packet recited in claim 9.

Misra also discloses that logon certificates may be created though the use of asymmetric encryption (public/private key encryption) mechanisms (See Misra, Col. 5, Lines 21-29). Misra further discloses that each domain has a an associated public and private key pair (See Misra 31-33). In contrast, claim 9 recites encrypting all certificates/private key using a public key associated with a token identification. Nothing in Misra discloses that any removable media, which the Examiner alleges reads on a token (See Final Office Action, Page 3), has an associated public key. Thus, the asymmetric encryption does not correspond to the encryption of all certificates/private keys, as recited in claim 9. Thus, the section of Misra cited in the Final Office Action does not disclose encrypting all certificates/private keys of a plurality of certificates/private keys which have not been downloaded to a token using a public key associated with a token identification in a database to form a download packet, as recited in claim 9. In fact, nothing in Misra discloses this element of claim 9.

Additionally, Misra does not disclose activating certificates/private keys in a download packet using a private key in a token. As stated above, the logon certificate disclosed in Misra is encrypted using a symmetric key scheme. Nothing in Misra discloses the employment of a private key during the decryption of the logon certificate disclosed in Misra. Consequently, Misra does not disclose activating certificate/private keys in a download packet using a private key in a token. Therefore, Misra does not disclose each and every element of claim 9. Accordingly, Misra does not anticipate claim 9, and therefore, claim 9 should be patentable over the cited art.

Claims 10-12, and 23-24 depend either directly or indirectly from claim 9 and are patentable over the cited art for at least the same reasons as claim 9 and for the specific elements recited therein. Accordingly, claim 10-12 and 23-24 should be patentable over the cited art.

It is respectfully submitted that the Examiner did not respond to all arguments set forth by Applicant for the rejection of claim 23 in pages 4-5 of the Final Response. Specifically, Misra does not disclose activating certificates/private keys further comprising the entry of a passphrase, as recited in claim 23. As stated above, claim 23 depends from claim 9. Claim 9, from which claim 23 depends, recites activating the certificates/private keys in a download packet using a private key in a token. Thus, claim 23 recites (by virtue of its dependence from claim 9) activating certificates/private keys by using a private key in a token and entering a passphrase. It is respectfully submitted that in rejecting claim 23, the Examiner attempts to use the same aspect of Misra (a downloading password) that was used in the rejection of claim 9 for disclosing two separate elements recited in claim 23, namely, the private key and the entry of a passphrase. If both the private key and the passphrase were considered to be the same element, claim 23 would be superfluous. Accordingly, it is respectfully submitted that the Examiner is not giving claim 23 patentable weight separate from claim 9. Accordingly, the currently pending rejection of claim 23 violates the doctrine of claim differentiation.

Regarding claim 18, Misra does not anticipate claim 18 for substantially the same reasons as claim 9. Accordingly, Misra does not anticipate claim 18, and therefore, claim 18 should be patentable over the cited art.

Claims 19-22, 26 and 28 depend either directly or indirectly from claim 18 and are patentable for at least the same reasons as claim 18 and for the specific elements recited therein. Thus, claims 19-22, 26 and 28 should be patentable over the cited art.

Additionally, claim 26 is not anticipated by Misra for substantially the same reasons as claim 23. That is, by virtue of the doctrine of claim differentiation, Misra does not disclose that activating occurs in response to a receipt of a passphrase, as recited in claim 26. Accordingly, Misra does not disclose each and every element of claim 26.

For the reasons described above, claims 9-13 and 18-28 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 13, 22, 25 and 27 Under 35 U.S.C. §103(a)

Claims 13, 22, 25 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Misra in view of U.S. Patent No. 6,192,131 B1 to Geer, Jr. et al. ("Geer"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claim 13 and 25 depend from claim 9, while claims 22 and 27 depend from claim 18. The addition of Greer does not make up for the aforementioned deficiencies of Misra with respect to claim 9 and claim 18.

Additionally, regarding claims 13, 22, 25 and 27, it is respectfully submitted that there is no motivation to combine and modify the teachings of Misra and Greer in the manner suggested by the Office Action. In the Final Response on pages 6-7, Applicant clearly set forth reasons that it would not be obvious to combine and modify the teachings of Misra and Geer in the manner suggested by the Examiner. Specifically, Misra provides no teaching or suggestion to implement smart cards. Greer provides no teaching or suggestion for the distribution of logon certificates. The Examiner states that the motivation is the implementation in a smartcard (See Final Office Action, Page, 2). However, the Examiner has not set forth any reason (other than the present application) as to why one skilled in the art of smart cards would look to employ the teachings of Misra. In Misra, encrypted data is stored on a non-secure removable media (a floppy diskette). In contrast, a smart card includes processing capabilities. Nothing in Misra teaches or suggests the removable storage media should include processing capabilities. Thus, it is respectfully submitted that the Examiner errored in finding motivation to combine and modify the teachings of Misra and Greer. Thus, Misra taken in view of Greer, does not make claims 13, 22, 25 and 27 obvious.

For the reasons described above, claims 13, 22, 25 and 27 should be patentable over the cited art. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Applicant respectfully requests reconsideration of this application and that the application be passed to issue.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,

Date 6-7-06

Christopher P. Harris
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